UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/736,802	MASTRIANNI ET AL.
	Examiner	Art Unit	
	Joshua Joo	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>16 December 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-36</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>16 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detailed Action

1.   Claims 1-36 are presented for examination.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 25-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant is seeking to patent a computer program product. In the specification on page 3, line 4 of the instant application, Applicant has provided evidence that the claimed computer program product is intended to be software. Software does not meet one of the four categories of invention and is not statutory. Specifically, software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a composition of matter.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 6, 8, 11, 18, 20, 30, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

    i)   Regarding claims 8, 20, and 32, the phrase, "said data transfer link comprises one of a
            wireless link and an infrared link" is not clear. Since the phrase recites "and" and not in
            an alternative form, it is not clear if the data transfer link is intended to comprise a

            wireless link that is an infrared link or a data transfer link that comprises a wireless or an infrared link.

ii)   Regarding claims 6, 18, and 30, "said data sets" and "the order" lack sufficient antecedent basis.

iii)   Regarding claim 11, for the phrase "permitting normal backup of files on said client computer", it is not clear if the feature of normal backup of files on the computer is part of claimed invention or is used as a reason or an example of why transferred of data is suspended.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-2, 7-8, 13, 16, 19-20, 25-26, 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang, US Publication #2004/0125782 (Chang hereinafter).

8.   As per claims 1 and 25, Chang teaches the invention as claimed including in a system having a client computer, and apparatus for connecting said client computer to a network having a server for backing up said client computer, a method for transferring data from said client computer to said server, comprising:

        connecting said client computer to said network (Paragraph 0040. Computing device. Paragraph 0060. Device in wireless communication.);

        backing up data on said client computer to a storage device attached to said network when said client computer is connected to said network (Paragraphs 0060-0061. Send content to comm. device for storage.); and

transferring the data from said storage device to said server (Paragraphs 0039; 0062. Data is transferred to the computing device 170.).

9.   As per claim 13, Chang teaches the invention as claimed including a system for backing up data on a client computer to a server on a network, said system comprising:

connection apparatus for connecting said client computer to said network (fig. 1; Paragraph 0040. Computing device. Paragraph 0060. Device in wireless communication. An interface is essential for network connection.); and

a storage device connected to said network for backing up data from said client computer when said client computer is connected to said network (Paragraphs 0060-0061. Send content to comm. device for storage.), said storage device being configured to transfer said data to said server at a time determined by said server (Paragraph 0062. Data is transferred to the computing device 170. Computing device 170 automatically transfers data.).

10.   As per claims 2 and 26, Chang teaches the method as recited in claim 1, wherein said transferring of said data from said storage device to said server occurs at a time determined by said server (Paragraph 0062. Computing device 170 automatically transfers data.).

11.   As per claims 7, 19, and 31, Chang teaches the method as recited in claim 1, wherein said connecting comprises establishing a data transfer link between said client computer and said data storage device (Paragraphs 0060-0061. Transmit data from device 180 to comm. device 100.).

12.   As per claims 8, 20, and 32, Chang teaches the method as recited in claim 7, wherein said data

transfer link comprises one of a wireless link and an infrared link (Paragraphs 0034; 0093. Wireless

interface such as infrared).

13.   As per claim 16, Chang teaches the system as recited in claim 13, further comprising an interface

between said connection apparatus and said storage device, said interface having a processor to facilitate

transfer of data (Paragraph 0038; 0047. Processor. Paragraph 0061. Comm. device receives and stores

data transmitted from mobile device.).

14.   As per claim 30, Chang teaches the computer program product as recited in claim 25, wherein

said data sets are transferred to said server in the order in which said data sets were created (Paragraphs

0061-0062. Data stored (created) on the storage device is transferred to the computing device.).

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

16.   Claims 5-6, 17-18, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang.

17.   As per claims 5, 17, and 29, Chang teaches of connecting to the storage device and transferring

data from the client computer to the storage device upon a condition (Paragraphs 0058-0060). Chang also

teaches that data is transferred to the server (computer) manually by a user or automatically upon the

storage device's connection to the server (Paragraph 0062). Chang does not explicitly teach the method

as recited in claim 1, further comprising: connecting said client computer to said network a plurality of

times before said server backs up said data on said client computer, and creating a new data set on said

storage device for transfer to said server each time said client computer is connected to said network.

18.   However, according to Chang's teachings that backup of data is based on the storage's device

connection to the server or manually by the user, it would have been obvious to one of ordinary skill in

the art that the client computer in Chang's teachings may connect to the storage device a plurality of times

before data is sent to the server if the storage device is not connected to the server or if the user does not

manually back up the data each time.   It would have been also obvious to one of ordinary skill that data

may be transferred from the client computer to the storage upon each connection if the predetermined

condition for data transfer, as taught by Chang, is met each time the client computer connects to the

storage device, such as the client computer exceeding a memory threshold.

19.   As per claims 6 and 18, Chang teaches the method as recited in claim 5, wherein said data sets are

transferred to said server in the order in which said data sets were created (Paragraphs 0061-0062. Data

stored (created) on the storage device is transferred to the computing device.).

20.   Claims 3-4, 14-15, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Chang, in view of Christopher, US Publication #2002/0163780 (Christopher hereinafter).

21.   As per claims 3 and 27, Chang does not specifically teach the method as recited in claim 1,

wherein said connecting comprises connecting said client computer to a docking station connected to said

network.

21.   Christopher teaches a system for a synchronization docking station, wherein a client computer

connects to a docking station (fig. 1; paragraph 0018).   .

22.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the teachings of Chang and Christopher for a client computer to connect to a docking station.

The motivation for the suggested combination is that Christopher's teachings of connecting to a docking

station would improve Chang's system by implementing an apparatus capable of battery recharge of a

mobile device as taught by Christopher (Paragraph 0023).

23.   As per claims 4 and 28, Chang does not specifically teach the method as recited in claim 3,

wherein the storage device is associated with said docking station.

24.   Christopher teaches a system for a synchronization docking station, wherein a docking station

comprises a storage device (fig. 1; paragraph 0018).

25.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the teachings of Chang and Christopher for a docking station to comprise a storage device.

The motivation for the suggested combination is that Chang's teachings would provide additional storage

for backing up data and would achieve a desirable and predictable result of providing a battery recharge

of a mobile device as taught by Christopher (Paragraph 0023).

26.   As per claim 14, Chang does not specifically teach the system as recited in claim 13, wherein said

connection apparatus is a docking station for said client computer.

27.   Christopher teaches a system for a synchronization docking station, wherein a client computer

connects to a docking station (fig. 1; paragraph 0018).

28.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the teachings of Chang and Christopher for a client computer to connect to a docking station.

The motivation for the suggested combination is that Christopher's teachings of a docking station would

improve the Chang's system by implementing an apparatus capable of battery recharge of a mobile device as taught by Christopher (Paragraph 0023).

29.   As per claim 15, Chang does not specifically teach the system as recited in claim 14, wherein said storage device is associated with said docking station.

30.   Christopher teaches a system for a synchronization docking station, wherein a docking station comprises a storage device (fig. 1; paragraph 0018).

31.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chang and Christopher for a docking station to comprise a storage device. The motivation for the suggested combination is that Chang's teachings would provide additional storage for backing up data and would achieve a desirable and predictable result of providing a battery recharge of a mobile device as taught by Christopher (Paragraph 0023).

32.   Claims 9, 21, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, in view of Cho et al., US Patent #5,798,951 (Cho hereinafter).

33..   As per claims 9, 21, and 33, Chang teaches of transferring data stored on said storage device in said client computer to said storage device attached to said network. Chang does not specifically teach the method as recited in claim 1, wherein if said client computer is off when connected to said network, the method further comprises: powering up a storage device in said client computer.

34.   Cho teaches of a system for connecting a client (portable) computer to a docking station, wherein when the client computer is off when connected to the docking station, the portable computer is powered up (col. 9, lines 15-22).

35.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chang and Cho to implement a docking station, power up a turned off client computer when the client computer is connected to the network as taught by Cho, and transfer data stored on said storage device in said client computer to said storage device attached to said network as taught by Chang. The motivation for the suggested combination is that implementing a docking station would provide gains obvious to one of ordinary skill in the art such as support for additional interfaces and battery recharging. Furthermore, Cho's teachings would achieve the result of allowing the client computer to automatically power up without user action.

36.   Claims 10, 22, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang and Cho, in view of Fald, US Publication #2004/0073681 (Fald hereinafter).

37.   As per claims 10 and 34, Chang teaches the method as recited in claim 9, wherein the power to said client computer is turned on during transfer of data stored on said storage device in said client computer to said storage device attached to said network (Paragraphs 0060-0061. Send content to comm. device for storage. It is essential that power is turned on for data transfer.). Chang does not specifically said transfer of data is suspended while said client computer boots up.

38.   Fald teaches a system for backing up data to a server, wherein transferring of data is stopped when a client computer is turned off and transfers data when the client computer is turned on (booting) (Paragraph 0063).

39.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Chang and Fald to stop transfer of data when the client computer is booted, which would allow the computer to properly initialize and load files for operating the computer.

40.   As per claim 22, Chang teaches the method as recited in claim 9, wherein the power to said client computer is turned on during transfer of data stored on said storage device in said client computer to said storage device attached to said network (Paragraphs 0060-0061. Send content to comm. device for storage. It is essential that power is turned on for data transfer.). Chang does not specifically teach the system further comprising means for suspending transfer of data that is stored on said storage device in said client computer to said storage device attached to said network, while said client computer boots up,

41.   Fald teaches a system for backing up data to a server, wherein transferring of data is stopped when a client computer is turned off and transfers data when the client computer is turned on (Paragraph 0063).

42.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Chang and Fald to stop transfer of data when the client computer is booted, which would allow the computer to properly initialize and load files for operating the computer.

43.   Claims 11, 23, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, in view of Serichol Blasco, US Patent #6,892,288 (Blasco hereinafter) and Watanabe et al. US Publication #2004/0107315 (Watanabe hereinafter).

44.   As per claim 11, Chang does not specifically teach the method as recited in claim 1, wherein if said client computer is initially on when connected to said network, but said client computer is turned off, the method further comprises suspending transferring data stored on a storage device in said client computer to said storage device attached to said network, to permitting normal backup of files on said client computer.

45.   Blasco teaches of backing up data when a computer is turned off (col. 2, lines 25-31; claim 1).

46.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the teachings of Chang and Blasco to backup data when the computer is turned off. The

motivation for the suggested combination is that Blasco's teachings would provide the predictable result

of allowing backup of data on the available hard drives of a user computer as taught by Blasco.

47.   Chang teaches of transferring data to said storage device attached to the said network, but Chang

and Blasco do not specifically teach of suspending transferring data to said storage device.

48.   Watanabe teaches of stopping read/write of a volume during a backup process (Paragraph 0017).

49.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the teachings to stop reading the storage data including the reading involved when transferring

data to said storage device as taught by Chang during a normal backup process as previously taught by

Blasco. The motivation for the suggested combination is that suspending reading of a storage device

during a backup process such that one backup process is executed would improve the suggested system

with the predicable result of assuring consistency of data for backup as taught by Watanabe.

50.   As per claim 23, Chang does not specifically teach the system as recited in claim 13, further

comprising means for suspending normal backup of files on said client computer while transferring data

stored on a storage device in said client computer to said storage device attached to said network if said

client computer is initially on when connected to said network, but said client computer is turned off.

51.   Blasco teaches of backing up data on an internal or external drive when a computer is turned off

(col. 2, lines 25-31; claim 1).

52.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the teachings to backup data or an internal external drive when a computer is turned off as

taught by Blasco such that data is transferred (backed up) to said storage device attached to said network

as taught by Chang. The motivation for the suggested combination is that Blasco's teachings would

assure that data is backed up to an available storage drive.

53.   Chang does not specifically teach of suspending normal backup.

54.   Watanabe teaches of stopping read/write of a volume during a backup process (Paragraph 0017).

55.   A client computer backing up data is well known in the art such as backing up to an internal drive

as taught Blasco, and it would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings to stop reading the storage data for tasks such as a normal

backup when data is transferred to an external storage for backup as taught by Chang and Blasco. The

motivation for the suggested combination is that suspending reading of a storage device during a backup

process such that one backup process is executed would improve the suggested system with the

predicable result of assuring consistency of data for backup as taught by Watanabe.

56.   As per claim 35, Chang does not specifically teach the computer program product as recited in

claim 25, further comprising computer readable code means so that in the method, if said client computer

is initially on when connected to said network, but said client computer is turned off, the method further

comprising suspending normal backup of files on said client computer while transferring data stored on a

storage device in said client computer to said storage device attached to said network.

57.   Blasco teaches of backing up data on an internal or external drive when a computer is turned off

(col. 2, lines 25-31; claim 1).

58.   It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the teachings to backup data or an internal external drive when a computer is turned off as

taught by Blasco such that data is transferred (backed up) to said storage device attached to said network

as taught by Chang. The motivation for the suggested combination is that Blasco's teachings would

assure that data is backed up to an available storage drive.

59.   Chang does not specifically teach of suspending normal backup.

60.   Watanabe teaches of stopping read/write of a volume during a backup process (Paragraph 0017).

61.   A client computer backing up data is well known in the art such as backing up to an internal drive

as taught Blasco, and it would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings to stop reading the storage data for tasks such as a normal

backup when data is transferred to an external storage for backup as taught by Chang and Blasco. The

motivation for the suggested combination is that suspending reading of a storage device during a backup

process such that one backup process is executed would improve the suggested system with the

predicable result of assuring consistency of data for backup as taught by Watanabe.

62.   Claims 12, 24, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, in

view of Fanning et al. US Patent #6,742,023 (Fanning hereinafter).

63.   As per claims 12, 24, and 36, Chang teaches of transferring data from said storage to said server.

Chang does not specifically teach a condition in the method as recited in claim 1, wherein if said client

computer is disconnected from said network during a first backing up of data on said client computer to a

storage device attached to said network, and said client computer is again connected to said network, the

method further comprises backing up said client computer to said storage device on said network a second

time, and transferring sequentially to said server data transferred to said storage device before said client

was disconnected from said network, and then data transferred to said storage device during said second

time.

64.   Fanning teaches a system for transferring data between a client and server, wherein if there is a disconnection during file transfer, the file transfer is resumed when reconnected (col. 7, lines 49-55).

65.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chang and Fanning to resume file transfer after reconnection when there is a disconnection during the file transfer.   The motivation for the suggested combination is that Fanning's teachings to resume file transfer would allow efficient transmission of data by reducing the time and bandwidth required for retransmission.   It would have been also obvious to one of ordinary skill that if data is available on the storage device, it may be transferred first, i.e. in sequence, manually by the user or automatically in order to synchronize data.

Conclusion

66.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

i)   Qin et al. US Patent #6,910,151 teaches of stopping all tasks prior to backup.

ii)   Eastridge et al. US Patent #RE37,038 teaches of a backup program suspending execution of applications.

ii)   Umbehocker et al. US Publication #2004/0010666 suspending applications accessing storage data during backup to assure consistency.

67.   A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

68.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

69.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this

application or proceeding is assigned is 571-273-8300.

70.   Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained

from either Private PAIR or Public PAIR. Status information for unpublished applications is available

through Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

December 7, 2007
JJ